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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,674	12/06/2001	Arnold Oliphant	1410.01	8264

26698 7590 02/01/2006

MYRIAD GENETICS INC.  
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EXAMINER

HEINRICH, SAMUEL M

ART UNIT PAPER NUMBER

1725

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/009,674	OLIPHANT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Samuel M. Heinrich	1725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP000670195A1 in view of JP408174263A and further in view of Applicant's Admitted Prior Art (AAPA). EP000670195A1 describes laser ablation of fluorocarbon resin. JP408174263A describes laser absorption response. AAPA comprises USPN 5,320,789 to Nishii et al who describe wt.% of light-absorbing polymeric material in fluorine resin, e.g., claim 10. EP000670195A1 describes using a laser for ablation of fluorocarbon resin in order to remove material. The material is altered to contain different colors or pigments and the laser ablation varies depending on the different

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color. EP000670194A1 does not particularly state the colored materials are UV absorbing materials. JP408174263A describes the absorption response of resin materials containing inorganic particles such as carbon black and pigments have to laser beam irradiation. Resin materials containing either carbon black or pigments have a similar response with respect to laser absorption. The use of carbon black in the EP000670195A1 process would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because it is well known in the art that color pigments and carbon black both have the effect of absorbing laser energy. With respect to the instant claimed amount of UV absorbing material present (claims 2, 3, 8-15, 19, 20, 22, and 26), the EP000670195A1 describes various levels of reflectance which are desirable for optimum material removal, and the use of the instant claimed amounts of UV absorbing material would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the properties of the materials such as layer thickness or type and size of the substrate. Nishii et al also disclose well known wt.% amounts of light-absorbing material in fluorine resin material subject to laser ablation and the amounts are in applicant's claimed range. With respect to the instant claimed laser light wavelength and fluence, the use of a particular laser beam would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the properties of the coating and substrate materials being irradiated and on the available laser apparatus. Articles containing geometrical physical structures are well known in the art. Microfluidic structures are well known in the art.

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Claims 21, 23-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP000670195A1 in view of JP408174263A and in view of AAPA as applied to claims 16, 22, and 23 above, and further in view of JP359090244A. EP000670195A1 pertains to ablation of an entire surface. JP359090244A describes selective laser formation of structure such as holes by ablation of a fluorocarbon containing material. The instant claimed step of forming microchannels or wells in the a substrate by using a laser with a fluorocarbon material comprising a laser light absorbing material such as carbon black would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the forming of structural shapes with a laser is well known in the art and because selective laser light absorption for material treatment is well known in the art. Articles containing geometrical physical structures are well known in the art. Microfluidic structures are well known in the art.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Copy of IDS, received February 06, 2005 and not considered, is attached hereto.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP410287784A describes fluorocarbon resin which comprises composite particles and describes the interception of ultraviolet rays.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

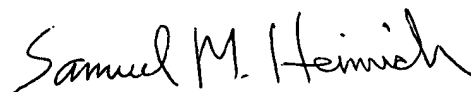
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel M Heinrich  
Primary Examiner  
Art Unit 1725

SMH